

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed September 30, 2005. At the time of the Office Action, Claims 1, 2, 4-8, 10, 11, 13-15, and 17-22 were pending in this Application. Claims 3, 9, 12, 16 and 23 were previously cancelled without prejudice. Claims 1, 2, 4-8, 10, 11, 13-15, and 17-22 were rejected. Claim 17 has been amended. Applicant respectfully requests reconsideration and favorable action in this case.

Claims Objections

Claim 17 was objected to by the Examiner for being dependant upon cancelled Claim 16. Applicant amends Claim 17 to overcome this objection.

Claim Rejections under 35 U.S.C. § 103

Claim 1 was rejected under 35 U.S.C. § 103(a) as being obvious over Applicant's Admitted Prior Art in view of U.S. Patent 6,208,345 issued to Nicolas C. Sheard et al. ("Sheard et al."). Applicant respectfully disagrees with this rejection.

Claims 2, 4-6, 10, 11, 13-15, and 19 were rejected under 35 U.S.C. § 103(a) as being obvious over Applicant's Admitted Prior Art in view of U.S. Patent 6,208,345 issued to Nicolas C. Sheard et al. ("Sheard et al.") as applied to Claim 1 above, and further in view of U.S. Patent 6,549,922 issued to Alok Srivastava et al. ("Srivastava et al."). Applicant respectfully disagrees with this rejection.

Claims 7, 8, 17 and 20 were rejected under 35 U.S.C. § 103(a) as being obvious over Applicant's Admitted Prior Art in view of Srivastava et al., as applied to Claim 1 above, and further in view of U.S. Patent 5,878,220 issued to Jeffrey C. Olkin et al. ("Olkin et al."). Applicant respectfully disagrees with this rejection.

Claims 18, 21 and 22 were rejected under 35 U.S.C. § 103(a) as being obvious over Applicant's Admitted Prior Art in view of Sheard et al., as applied to Claim 1 above, and further in view of non-patent document "The Gemini Telescope Control System" by Taylor et al. ("Taylor et al."). Applicant respectfully disagrees with this rejection.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The Examiner stated that APA teaches the invention substantially as claimed except that APA does not teach a system that converts data which allegedly is taught by Shearn. Applicant respectfully disagrees.

The prior art does not teach the invention substantially because the substance of the invention is to use a different data format between the engineering system and the runtime system. APA is neither designed to use such a format nor suggests to use such a format. The fact that APA and the present invention use a similar structure is due to the general structure of automation systems that use an engineering system and a runtime system. These systems are thus unique by using two independent sub-systems which allow for creating automation systems.

The Examiner cited Sheard for proposing to convert data generated by one system for another system. However, Applicant believes that there is no motivation for a person skilled in the art to combine this prior art with the existing technology and even if combined that such a combination of Sheard and APA would not result in the structure and method as claimed in the independent claims.

The present independent claims include an engineering system and a runtime system. These systems are independent systems and their respective functionality are

well known by someone skilled in the art. The specification also defines the functionality of these systems as stated above.

Sheard teaches a completely different structure than APA. According to Sheard, different applications (Application #1, #2, #3, and #4) can communicate with each other by means of a data exchange infrastructure 33. Thus, proprietary data to one application is converted into a standardized data format that can be visualized by a visual interface 31. See col. 6, lines 7-60. Thus, each application sends and receives data in its respective proprietary form. The system according to Sheard proposes to use a data exchange structure as an interface between the different applications.

Contrary to such a concept, the present invention proposes that any data exchange between the engineering system and the runtime system is performed using a format that a standard Internet client can read. An external Internet client is however only coupled with the runtime system. Thus, according to the present invention, the engineering system and the runtime system are designed in a completely different way than the respective systems of the prior art. A combination of the prior art and Sheard would merely introduce a data exchange infrastructure between the engineering system and the runtime system.

Thus, Applicant believes that the prior art cited does not render the present invention as claimed in independent claims 1 and 10 obvious. Applicant respectfully submits that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicant respectfully requests reconsideration and allowance of the dependent Claims. Applicant reserves the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and does not concede that the Examiner's proposed combinations are proper.

Change of Correspondence Address

Applicant respectfully requests that all papers pertaining to the above-captioned patent application be directed to Customer No. **31625** and all telephone calls should be directed to Andreas Grubert at 512.322.2545.

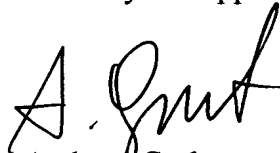
CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of all pending Claims.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2545.

Respectfully submitted,
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Andreas Grubert
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Date: December 29, 2005

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